

REMARKS/ARGUMENTS

I. The Office Action and Claim Amendments

In the above-mentioned Office Action, claims 19-26, 29, 44-48, 50, 52, 54-55, 57-62, 65, 67, 69, 71-73, 75, 77, 79-81, 84-85, 87-90, 92 and 94-96 were rejected as being anticipated by U.S. Patent No. 4,188,251 (Grass); claims 27-28, 49, 56, 63-64, 66, 68, 70, 74, 78, 86, 91 and 93 were rejected as being unpatentable over U.S. Patent No. 4,188,251. In response thereto, claims 19, 44, 57, 65, 67, 73, 75, 77, 89 and 92 have been amended, and claims 46 and 90 cancelled without prejudice or disclaimer.

II. Brief Discussions of the Independent Claims

Independent claim 19 includes the labels being separated by non-label portions of the facestock sheet.

Independent claim 44 is simply dependent claim 46 rewritten in independent format. Independent claim 44 includes the uncut material and also the weakened line segments being cut lines. In contrast, Grass shows microperf lines, and not cut lines.

Independent claim 50 similarly includes cut lines and short sections of uncut material.

Independent claim 57 includes first, second, third and fourth weakened line segments.

Independent claim 65 includes the line portion which passes through the label as not being a weakened line portion.

Independent claim 67 includes the label being positioned within a perimeter of the facestock sheet and spaced a distance inward of side and edges of the perimeter and spaced therefrom by non-label waste portions of the facestock sheet.

Independent claim 69 includes at least one non-label facestock waste portion outside of the label and the line segments being on the waste portion and not on the label.

Independent claim 73 includes adhesive coating the entireties of all bottom surfaces of all the labels. In contrast, Grass shows the adhesive on only part of the

labels.

Independent claim 75 includes the labels being spaced from one another with non-label facestock sheet waste material. It further includes the weakened fold line, including die-cut line segments spaced from the labels by short sections of uncut material.

Independent claim 77 includes adhesive coating the entireties of all bottom surfaces of all the labels.

Independent claim 84 includes first, second and third labels as defined, and the same line passing through both the first and second labels.

Independent claim 89 is simply dependent claim 90 rewritten in independent format. It includes the novel arrangements of the first, second, third and fourth labels.

Independent claim 92 includes the arrangement of the weakened fold line and the first labels.

III. "Adapted to" Imparts Structural Claim Limitations

The claims use the phrase "adapted to" (or more particularly, "constructed and adapted to" in some of the claims). While it is true that a statement of intended use in a preamble of a claim may impart no structural limitations, the descriptive phrase "adapted to" in a claim body imparts structural limitations. In fact, as a matter of law, language in the body of a claim following the descriptive phrase "adapted to" is a structural limitation, and must be considered in a patentability determination. For example, in In re Venezia, 530 F.2d 956, 957, 189 USPQ 149, 150 (CCPA 1976), some of the claim language at issue was "a pair of sleeves of elastomeric material ... adapted to be fitted over the insulating jacket of one of said cables." Concerning the above-quoted aspect of the claim, the Court of Customs and Patent Appeals stated that "rather than being a mere direction of activities to take place in the future, this language imparts a structural limitation to the sleeve. Each sleeve is so structured and dimensioned that it can be fitted over the insulating jacket of the cable." Id. at 959, 189 USPQ at 151-152, emphasis added. (See also In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).)

It is also well settled that all claim limitations must be considered and that it is

improper for an examiner to ignore specific limitations that distinguish over the cited references. See, e.g., In re Boe and Duke, 505 F.2d 1297, 1299, 184 USPQ 38, 40 (CCPA 1974).

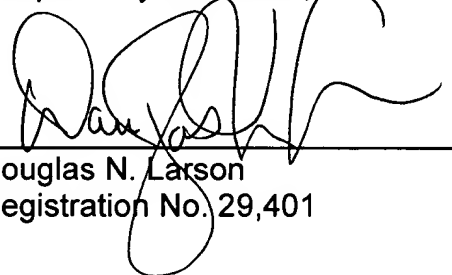
IV. Concluding Remarks

Accordingly, it is respectfully contended that all of the claims now pending are patentable over the prior art of record. Issuance of the Notice of Allowance at an early date is in order.

If there are any remaining issues, the examiner is encouraged to telephone the below-signed counsel at (213) 689-5142 to seek to resolve them.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1853. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Douglas N. Larson", is written over a horizontal line.

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